



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/723,040 | 11/26/2003 | Keith C. Hullfish | AOL0126 | 7812 |
| 22862 | 7590 | 10/25/2007 | EXAMINER | |
| GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025 | | | BHATIA, AJAY M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2145 | | |
| | | MAIL DATE | DELIVERY MODE | |
| | | 10/25/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/723,040 | HULLFISH ET AL. | |
| | Examiner | Art Unit | |
| | Ajay M. Bhatia | 2145 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 8/29/07.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-61 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-61 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 August 2007 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

Response to Arguments

Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection. Applicant has filed an RCE 8/29/07.

Terminal Disclaimer

The terminal disclaimer filed on 8/29/07 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 6,714,793 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Drawings

The drawings were received on 8/29/07. These drawings are accepted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dehlin (U.S. Patent 6,957,077) in view of Goodspeed (US Patent Application Publication 2002/0065828).

For claim 1, Dehlin teaches, a method of transmitting electronic messages in a computer environment, comprising the steps of:

determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier; (Dehlin, Col. 5 lines 13-21, msn messenger, Col. 7 lines 20-25, chat)

and performing a step from a group of steps consisting of:

forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; (Dehlin, Col. 6 lines 35-60, alias status, computing device)

and sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier. (Dehlin, Col. 6 lines 35-60, mobile device)

Dehlin fails to clearly disclose receiving an original electronic message addressed to a telephone number; determining an instant message identifier associated with the telephone number;

Goodspeed teaches, disclose receiving an original electronic message addressed to a telephone number; (Goodspeed, paragraph 9, instant message directly to an intedneted

recipient by using one of the recipient telephone numbers) determining an instant message identifier associated with the telephone number; (Goodspeed, paragraph 340, rout message to instant message)

Dehlin and Goodspeed are both in the field of electronic messaging

Goodspeed is compatible with Dehlin, because Goodspeed has an interface to the system of Dehlin messaging

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Dehlin and Goodspeed, because Goodspeed provides the benefit of being used in emergencies (Goodspeed paragraph 16).

For claim 2, Dehlin-Goodspeed teaches, the method of claim 1, wherein the electronic message comprises any of:

a text message, an SMS text message, an MMS message, a video message, and an audio message. (Dehlin, Col. 5 lines 1-5, sms)

For claim 3, Dehlin-Goodspeed teaches, the method of claim 1, wherein the instant message is received at an electronic device configured to receive instant messages addressed to the instant message identifier. (Dehlin, Col. 6 lines 35-60, alias)

For claim 4, Dehlin-Goodspeed teaches, the method of claim 3, wherein the electronic device comprises any of:

a computer, a personal data assistant (PDA), and a telephone receiver. (Dehlin, Col. 6 lines 12-27, cell phone)

For claim 5, Dehlin-Goodspeed teaches, the method of claim 1, wherein the determining the instant message identifier comprises searching for the instant message identifier associated with the telephone number in a database. (Dehlin, Col. 6 lines 35-60, alias, database)

For claim 6, Dehlin-Goodspeed teaches, the method of claim 1, further comprising the step of:

determining whether or not to forward the electronic message as an email message addressed to an email address according to a user preference stored in a database. (Dehlin, Col. 6 lines 35-45, "alias not available.")

For claim 7, Dehlin-Goodspeed teaches, the method of claim 1, further comprising the step of:

determining whether or not to forward the electronic message as an instant message addressed to the instant message identifier according to a user preference stored in a database. (Dehlin, Col. 5 lines 13-21)

For claim 8, Dehlin-Goodspeed teaches, the method of claim 7, wherein the determining whether or not to forward is further based on source information of the electronic message. (Dehlin, Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep)

For claim 9, Dehlin-Goodspeed teaches, the method of claim 8, wherein the source information comprises any of:

a source address of the electronic message, a user name of a sender of the electronic message, a telephone number of a sender of the electronic message, and an instant message identifier of a sender of the electronic message. (Dehlin, Col. 6 lines 35-60, alias)

For claim 10, Dehlin-Goodspeed teaches, the method of claim 1, wherein the instant message is generated from the electronic message based on one or more predetermined rules. (Dehlin, Col. 7 lines 20-30, message)

For claim 11, Dehlin-Goodspeed teaches, the method of claim 10, wherein the one or more predetermined rules select one or more portions of the electronic message as the instant message. (Dehlin, Col. 7 lines 47-52, sms mobile device)

For claim 12, Dehlin-Goodspeed teaches, the method of claim 10, wherein the one or more predetermined rules selectively delete one or more portions of the electronic

message to generate the instant message. (Dehlin, Col. 7 lines 47-52, sms mobile device)

For claim 13, Dehlin-Goodspeed teaches, the method of claim 1, further comprising the step of forwarding the electronic message to a storage medium. (Dehlin, Col. 7 lines 41-46, reply)

For claim 14, Dehlin-Goodspeed teaches, the method of claim 1, further comprising the step of storing the electronic message in the storage medium. (Dehlin, Col. 7 lines 32-40, computer)

For claim 15, Dehlin-Goodspeed teaches, the method of claim 1, further comprising the step of:

determining whether or not to forward the electronic message to the storage medium according to the user preference stored in the database. (Dehlin, Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep)

For claim 16, Dehlin-Goodspeed teaches, the method of claim 1, further comprising the step of:

forwarding the electronic message to the storage medium when the forwarding to the mail address and the instant message identifier fails . (Dehlin, Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep)

For claim 17, Dehlin-Goodspeed teaches, the method of claim 15, wherein the determining whether or not to forward is further based on source information of the electronic message. (Dehlin,) Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep

For claim 18, Dehlin-Goodspeed teaches, the method of claim 15, wherein the user preference stored in the database comprises date and time preference of the instant message receiver. (Dehlin, Col. 6 lines 35-45)

For claim 19, Dehlin-Goodspeed teaches, the method of claim 1, further comprises the step of logging the forwarding the electronic message. (Dehlin, Col. 7 line 66 to Col. 8 line 11, sms)

For claim 20, Dehlin-Goodspeed teaches, the method of claim 1, further comprises blocking the forwarding of the electronic messages based on a list of telephone numbers. (Dehlin, Col. 6 lines 35-60, alais)

For claim 21, Dehlin-Goodspeed teaches, the method of claim 1, wherein the forwarding is based on the one or more predetermined rules. (Dehlin, Col. 7 lines 47-55, customize)

Claims 22-60 list all the same elements of claims 1-21, relating to the same invention. Therefore, the supporting rationale of the rejection to claims 1-21 applies equally as well to claims 22-60.

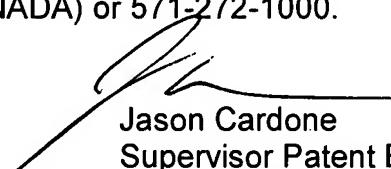
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of references cited (if appropriate).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Cardone
Supervisor Patent Examiner
Art Unit 2145

AB